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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,558	06/09/2005	Alfred Bernhard	SB-521	4338
24131	7590	10/19/2006	EXAMINER	
LERNER GREENBERG STEMER LLP			MAI, NGOCLAN THI	
P O BOX 2480			ART UNIT	
HOLLYWOOD, FL 33022-2480			PAPER NUMBER	

1742  
DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/533,558

**Applicant(s)**

BERNHARD ET AL.

**Examiner**

Ngoclan T. Mai

**Art Unit**

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9, 10 and 12-18 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/18/06</u> . | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. Claims 9-18 are pending with claim 9 amended and claims 17-18 newly added.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 102***

3. Claims 9, 12, 13, 16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 10-296650 now JP'650.

JP'650 disclose a screwdriver bit formed of cemented carbide having binder such as Co, Ni and Cr in the amount of 15-25% and the remainder WC, see abstract. The particle size of WC is less than 5 micron. JP'650 particularly discloses WC with particle size 0.5 micron and 1.0 micron in Table 3. The screwdriver bit of JP'650 has plurality of parallel grooves formed therein at approximately 45 degree to a longitudinal axis of the screwdriver bit directly beneath a screwdriver tip, see JP' 650 drawing. Since the screwdriver bit of the reference is formed from the same hard metal alloy as the present invention it is inherently resistant to both wear and torsional loads as claimed by the applicant. As for claim 16 JP'650 is silent about how the screwdriver bit is made, however there is no distinction between the patent's screwdriver bit and that of the instant claim. Therefore even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. An if the product in the product-by-process claim is the same as or obvious from a product of the prior art the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ964, 966 (Fed. Cir. 1985).

As for claim 18, it appears the claimed property is material property. Consequently, the properties as recited in the instant claims would have inherently possessed by the teachings of the cited reference. Therefore, the burden is on the applicant to prove that the product of the prior art does not necessarily or inherently possess characteristics attributed to the claimed product. *In re Spade* 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990), *In re Best*, 195 USPQ 430 and MPEP § 2112.01.

***Claim Rejections - 35 USC § 103***

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-296650, now JP '650. While JP'650 does not specifically teach the disclose employing tungsten carbide having mean size in a range from 0.7 to 0.9 micron, however, when prior art compounds essentially "bracketing" the claimed compounds in structural similarity are all known, one of ordinary skill in the art would clearly be motivated to make those claimed compounds in searching for new products in the expectation that compounds similar in structure will have similar properties. In re Gyurik, 596 F.2d 1012, 1018, 201 USPQ 552, 557 (CCPA 1979); See In re May, 574 F.2d 1082, 1094, 197 USPQ 601, 611 (CCPA 1978) and In re Hoch, 57 CCPA 1292, 1296, 428 F.2d 1341, 1344, 166 USPQ 406, 409 (1970). Therefore, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the subject matter disclosed by the reference. Overlapping ranges have been held to be a prima facie case of obviousness. See In re Malagari, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

5. Claims 14-15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP'650 in view of Holland-Letz (2004/0139829, art of record)

JP'650 differs from the claim in that JP'650 does not teach method of forming screwdriver bit by injection molding and machining a plurality of parallel web-like elevations.

Holland-Letz discloses it is known to form screwdriver bits by injection molding, see [0003]. Holland-Letz teaches machining the grooves to form parallel-web-like elevation is also known [0005]. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the screwdriver bit of JP'650 by injection molding method as this is a well known method for making such object.


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6. Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoclan T. Mai whose telephone number is (571) 272-1246. The examiner can normally be reached on 9:30-6:00 PM Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Ngoclan T. Mai  
Primary Examiner  
Art Unit 1742

n.m.